

APPLICATION NO. 10/735,797	FILING DATE 12/12/2003	FIRST NAMED INVENTOR Daniel Sheinbein	ATTORNEY DOCKET NO. 2003P09833US01
			EXAMINER Michael T. Vu
Response To Non-Final Official Action			
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REMARKS

Claims 1-9, 12-21 and 24-34 are pending. Claims 10, 11, 21, 22 and 23 are cancelled without disclaimer or prejudice. Claims 1, 7, 13-20, 24 and 25 have been amended. Independent claims 1, 13 and 25 have been amended to clearly distinguish over the current prior art of record including that submitted in an IDS simultaneously herewith and prior art cited therein. Claim 7 has been amended solely to clarify the claimed subject matter. Claims 14-20, and 24 have been amended to be consistent with claims from which they depend. Claims 26-34 are newly added and directed to additional novel aspects of the invention. Support for the claim amendments may be found at least on page 8, page 9, lines 12 to page 10, line 24 and Figs. 1 and 2. No new matter is added. Reconsideration of the application is respectfully requested in view of the above amendments and following remarks.

35 §103(a) Rejections

In the Office Action, claims 1-9, 11-20 and 24 have been rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,153,902 to Buhl ("Buhl") in view of U.S. Patent No. 6,366,660 to Baiyor ("Baiyor"). Claims 10, 11, 21-23 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Buhl and Baiyor further in view of U.S. Patent Publication No. 2004/0003070 to Fernald ("Fernald"). Applicants respectfully traverse these rejections.

First, the rejections of claims 10, 11 and 22-23 are rendered moot since these claims have been cancelled. Referring the Examiner now to MPEP § 2143, titled "**Basic Requirements for a *Prima Facie* case of Obviousness**", the MPEP mandates that:

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claimed limitations.

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Applicants submit that a prima facie case of obviousness has not been made because the applied references do not disclose or suggest all the claimed limitations, as amended herein. Moreover, there is no motivation to combine Buhl and Baiyor, as Buhl teaches away from the claimed inventions.

Buhl is directed to a mobile communications system in which mobile units M1-M4 may roam in a number of exchanges E1-E4 in a plurality of service areas A1-A4 (col. 4, lines 38-51). A home exchange 8 maintains an uncertainty list which is used to keep track of where a mobile station might be. The list is refreshed occasionally if a mobile station has not registered within a particular exchange within a period of time (col. 7, lines 30-45). The list contains those locations (i.e., service areas) that the mobile station might be (col. 3, lines 57-63 and col. 4, lines 14). When a call is received for the mobile user, a page to locations (i.e., service areas) in the list are made to locate the mobile user and if a response is received from the mobile user, the call is then routed to the mobile user (col. 5, lines 12-15 and col. 7, line 46 to col. 8, line 22).

Baiyor is directed to a system that provides variable alert patterns for multiple leg telecommunication sessions for providing concurrent or sequential alerting (Abstract). A call is placed to a special directory number ("DN"), referred to as a pilot number, for flexible alerting. Secondary DNs may be associated with the pilot number such that when a call is place to the pilot number all of the secondary DNs are alerted creating multiple call legs to the differing DNs. Which ever leg is first to answer, will receive the call (col. 5, lines 23-47).

However, neither Buhl nor Baiyor discloses or suggests various limitations as required by independent claims 1, 13 and 25 as amended herein. For example, independent claim 1 requires, in part:

determining at a first network element whether redirecting of the call to a second network element is active, and if active:

redirecting the call to the second network element;

checking at the second network element whether at least one of simultaneous and sequential routing is active... (Emphasis added)

Independent claim 13 requires, in part:

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a first network element to receive a call that specifies a destination address, the first network element to determine whether redirecting the call to a second network element is active...

the second network element to check whether at least one of simultaneous and sequential routing is active...(Emphasis added)

Independent claim 25 requires, in part:

a first software component associated with a first network element to receive a call that specifies a destination address and to determine whether redirecting the call to a second network element is active...

a second software component associated with a second network element to check whether at least one of simultaneous and sequential routing is active.

a third software component to originate call legs for subscriber destinations in the list... (Emphasis added)

Applicants submit that neither Buhl nor Baiyor, either singly or in combination, discloses or suggests these limitations of independent claims 1, 13 and 25. Further, no other prior art of record supplies the missing limitations.

Moreover, Applicants submit that there is no motivation to combine Buhl with Baiyor as Buhl discloses that the mobile system of Buhl uses a page first and route later approach (see col. 8, lines 40-62). Buhl searches for where the destination mobile station might be by paging. In a mobile system, it is useful to locate where the particular subscriber is before routing. Paging is not establishing call legs and is meant to avoid creating call legs which is the intention of page first and route later philosophy. In Buhl, it is the routing information that creates a call connection to a particular subscriber and occurs only after the paging phase. Buhl specifically states, by contrasting with the prior art, that the routing occurs after paging (col. 8, lines 43-62). Therefore, Buhl actually teaches away from creating multiple legs, hence there is no motivation to combine Buhl with Baiyor.

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Therefore, Applicants submit, for at least these reasons, that the rejections of Independent claims 1, 13 and 25, and all the claims depending therefrom, respectively, should now be withdrawn.

35 §102(b) Rejection

In the Office Action, claim 25 has been rejected under 35 U.S.C. 102(b) as being unpatentable over Baiyor. Applicants respectfully traverse this rejection.

For anticipation of a claim under 35 U.S.C. § 102, a single prior art reference must contain each and every limitation of the claim, either expressly or under the doctrine of inherency. *Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 1570 (Fed. Circ), cert. denied, 488 U.S. 892 (1988). For a reference to inherently have a limitation the reference must describe an apparatus or method which must necessarily have the subject limitation to operate in the manner that is described. See *Continental Can Company USA, Inc. v. Monsanto Co.*, 948 F.2d 1264, 20 USPQd 1746 (Fed. Cir. 1991).

As noted above in relation to the 103(a) rejection of claim 25, claim 25, as amended herein, recites various limitations not disclosed or suggested by Baiyor, including for example:

a first software component associated with a first network element to receive a call that specifies a destination address and to determine whether redirecting the call to a second network element is active...

a second software component associated with a second network element to check whether at least one of simultaneous and sequential routing is active,

a third software component to originate call legs for subscriber destinations in the list... (Emphasis added)

Applicants submit that the 102(b) rejection of claim 25 should now be withdrawn. Since neither Baiyor nor any of the other prior art of record discloses or suggests all the limitations of claim 25, Applicants submit that claim 25 and the claims depending therefrom are allowable.

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Newly Added Claims

New claims 26-34 are dependent claims directed to further aspects of the invention not disclosed or suggested in the art of record. Favorable action of these claims is respectfully requested.

Conclusion

In view of the foregoing amendments and remarks, Applicants submit that all of the rejections have been rendered moot and that the claims are in condition for allowance. The Examiner is invited to contact the undersigned at the telephone number listed below, if needed. Applicants hereby make a written petition for extension of time if needed. Please charge any deficiencies and credit any overpayment of fees to Deposit Account No. 19-2179.

Respectfully submitted,



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